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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,129	11/28/2001	John William Sweitzer	AUS920010639US1	1409

7590 01/04/2005  
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EXAMINER

CHANNAVAJJALA, SRIRAMA T

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/996,129	<b>Applicant(s)</b> SWEITZER ET AL.	
	<b>Examiner</b> Srirama Channavajjala	<b>Art Unit</b> 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Examiner acknowledges applicant's response to office action filed on 7/30/2004.
2. Examiner acknowledges applicant's "Declaration under 37 CFR 1.131", and Exhibit-A and Exhibit-B filed on 7/30/2004.
3. **Applicant fail to specifically point out or map specific portions and dates that corresponds to specific limitation of the Claims 1-20 in the applicant's submitted both Affidavit or Declaration Under 37 CFR 1.131 and work.**

In 37 CFR 1.131(b) "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained. See MPEP 715

For example in the independent claim 1 is directed to **A method of calibrating a topography for a client, said method comprising:** corresponds to which specific part of the applicant's work? [Exhibit "A", Exhibit "B"]

**Identifying one or more client attributes corresponding to the client:**  
corresponds to which specific part of the applicant's work?

**Comparing the identified client attributes to one or more topographical components;** corresponds to which specific part of the applicant's work?

**Selecting one or more of the topographical components based on the comparing; and** corresponds to which specific part of the applicant's work?

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**Installing the selected topographical components on one or more client computer system.** corresponds to which specific part of the applicant's work?

In the Declaration under 37 CFR 1.131, applicant submits that Exhibit "A", and Exhibit "B" includes the structure that is now recited in claims 1,8,14, however, upon considering applicant's Exhibit "A", and Exhibit "B", examiner cannot find applicant's claims 1,8,14 in the Exhibit "A", and Exhibit "B". It is further noted from the "Declaration under 37.CFR 1.131" page 1 of 2, item 2 (a), applicant admitted that "**Each of the dates deleted from Exhibit A**" is prior to July 6, 2000. Examiner cannot determine exact date of the exhibits.

Therefore, applicant is hereby required to provide all required information that including **specifically pointing out or mapping each claim limitation [claims 1-20] into his/her submitted Exhibit "A", and Exhibit "B"** in response to this office action.

### ***Drawings***

4. The drawings filed on 11/28/2001 are approved by the Draftsperson under 37 CFR 1.84 or 1.152.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claim 1-20 of copending Application No. 09/996,131 is now Pub. No. US 2003/0101250 A1.

Claims of co-pending application SI.No. 09/996,131 contains(s) every element of Claims 1-20 of the instant application and as such anticipates claims 1-20 of the instant application, and co-pending application claims are broader than the instant application claims.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed.Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6,8-12,14-19 rejected under 35 U.S.C. 102(e) as being anticipated by Sarno, US Pub.No. 2002/0042751 [filed on July 03, 2001].

8. As to Claims 1,8,14, Sarno teaches a system which including 'identifying one or more client attributes corresponding to the client' [page 7, 0073, line 1-7], client attributes corresponding to the client is equivalent to Sarno's business decision, manipulating the data, providing a summary that allows decision-makers and like as detailed in page 7, 0073; 'comparing the identified client attributes to one or more topographical components' [page 2, 0010, line 12-23], Sarno teaches for example comparing step with other relevant identified client attributes such as cost justification application that generate results, more specifically comparing step allows to determine different rollout schedules, suitability of different products to be evaluated, different expense rules and like that corresponds to more topographical components; 'selecting one or more of the topographical components based on the comparing' [page 2, 0010, line 12-23, page 2, 0012, line 21-22, page 3, line 1-3], Sarno specifically teaches for

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example user information selected from buyer information, rollout schedule information, expense rule information that corresponds to selecting one or more of the topographical components based on the comparing as detailed in page 2, 0012, line 21-22, page 3, line 1-3; 'installing the selected topographical components on one or more client computer system' [page 23, 0201, col 2, line 7-28, fig 32].

9. As to Claims 2,9,15, Sarno teaches a system which including 'grouping a plurality of calibration factors into one or more calibration sets, wherein the comparing further includes comparing the identified client attributes to the calibration factor sets' [page 19-20, 0173], Sarno specifically teaches database administrators and system administrators are responsible for managing administration activities that including monitoring, performance, system throughoutput, system availability, optimizing CPU utilization, load balancing, and processing various transactions related to business, examiner interpreting calibration factors corresponds to managing group or team of personnel, business transactions, and system resource management as detailed in page 19-20, 0173.

10. As to Claims 3,10,16, Sarno teaches a system which including 'calibration factors are selected from the group consisting of centralized management, branch office management, transaction based, small team, hybrid management, discipline oriented management, resource oriented management, personal management and no management required' [page 20, 0178, fig 6-7, page 20, 0179, fig 8], Sarno specifically

teaches data warehouse monitoring solutions that including create/allow additional data warehouses toward more productive in terms of managing business, further it is noted that Sarno also teaches managing group, type of employees that impact financial projections as detailed in fig 6-7, page 20, 0178 that corresponds to overall managing business related issues including resource oriented, personal, transaction based management.

11. As to Claims 4,11,17, Sarno teaches a system which including 'storing one or more calibration factors corresponding to each of the topographical components in a component metadata file' [page 3, 0013, line 15-20, page 5, col 2, 0035, page 6, col 1, 0035], Sarno specifically teaches storing information related to cost justification system, further cost justification itself is about knowledge based information, processing the user information, results of financial summary and like that corresponds to metadata; 'comparing further includes comparing the identified client attributes with the calibration factors stored in the metadata file' [page 2, 0010, line 12-23], Sarno teaches for example comparing step with other relevant identified client attributes such as cost justification application that generate results, more specifically comparing step allows to determine different rollout schedules, suitability of different products to be evaluated, different expense rules and like that corresponds to more topographical components; 'identifying one or more components based on the comparing' [page 2, col 2, 0010, line 19-23]; 'retrieving the identified components from a topographical component library' [page 2, col 2, 0012, line 21-22, page 3, col 1, 0012, line 1-3].

12. As to Claims 5,12,18, Sarno teaches a system which including 'packing the selected topographical components in a topography installation file' [page 3, col 1, 0014, page 11, col 2, 0114, line 1-9], 'transmitting the topography installation file to the client computer system' [page 21, line 7-21].

13. As to Claims 6,13,19, the limitations of this claim have been noted in the rejection above. In addition, Sarno disclosed 'gathering the client attributes, the gathering including examining one or more attributes selected from the group consisting of client organization charts, client information technology, client surveys, client requirements, client physical environments, and client location data' [page 5, col 2, 0032-0033, fig 12].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 7,13,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarno, US Pub.No. 2002/0042751 [filed on July 03, 2001] as applied to claim 1,8,14 above, and further in view of Bowman-Amuah, US Patent No. 6662357.

15. As to Claim 7,14,20, Sarno teaches a system which including 'installing one or more topography application components' [page 23, 0201, col 2, line 7-28, fig 32]. It is however, noted that Sarno does not teach 'topography neutral application components is adapted to interoperate with more than one topography'. On the other hand, Bowman-Amuah disclosed "topography neutral application components is adapted to interoperate with more than one topography' [col 10, line 61-67, col 11, 1-32].

It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention to incorporate the teachings of Bowman-Amuah into business to business financial analysis of Sarno because both Sarno and Bowman-Amuah are directed to business applications, more specifically Sarno is directed to analyzing, presenting user information for cost justification, generating financial summaries and business cases [see Abstract], while Bowman-Amuah is directed to integrated development architecture framework, more specifically business management framework [see col 2, line 30-40].

One of the ordinary skill in the art at the time of applicant's invention to combine the references because that would have allowed users of Sarno to specifically implement the organization framework that including various business related items such as project organization, information management, configuration management, to effectively control and manage business tasks and resources, thus improving the quality and reliability of the system [see Bowman-Amuah: col 10, line 52-62].

### ***Response to Arguments***

16. Examiner considered Applicant's response to office action, especially remarks at page 10-12, filed on 7/30/2004 also examiner acknowledged applicant's enclosed Declaration under 37 CFR 1.131. Since applicant failed to specifically point out each claim limitation corresponds to applicant's submitted work in the "Declaration under 37 CFR 1.131", examiner hereby maintains previous Office action, mailed on 4/30/2004, for example Claims 1-6,8-12,14-19 rejected under 35 U.S.C. 102(e) as being anticipated by Sarno, US Pub.No. 2002/0042751 [filed on July 03, 2001] and Claims 7,13,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarno, US Pub.No. 2002/0042751 [filed on July 03, 2001] as applied to claim1, 8,14 above, and further in view of Bowman-Amuah, US Patent No. 6662357.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Conclusion***

**The prior art made of record**

- a. US Patent No. 6662357
- b. US Patent No 2002/0042751
- c. US Patent No. 2003/0101250

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure


- d. US Patent No. 2002/0191014
- e. US Patent No 6370578
- f. US Patent No 6700590
- g. US Patent No 2002/0120917
- h. US Patent No. 6151707
- i. US Patent No. 2002/0169658
- j. EP0869449

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is 571-272-4108. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popvici, can be reached on 571-272-4083. The fax phone numbers for the organization where the application or proceeding is assigned is 703/872-9306

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

sc  
*Patent Examiner.*  
December 21, 2004.

  
SRIRAMA CHANNAVAJJALA  
PRIMARY EXAMINER